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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,414	04/19/2006	Kazunobu Watanabe	062423	2352

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WASHINGTON, DC 20036

EXAMINER
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AUGHENBAUGH, WALTER

ART UNIT	PAPER NUMBER
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1782

NOTIFICATION DATE	DELIVERY MODE
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09/17/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/576,414	<b>Applicant(s)</b> WATANABE ET AL.	
	<b>Examiner</b> WALTER B. AUGHENBAUGH	<b>Art Unit</b> 1782	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2010 and 13 July 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 9, 2010 has been entered.

***Acknowledgement of Applicant's Amendments***

2. The amendment made in claim 1 in the Amendment filed June 9, 2010 has been received and considered by Examiner.

***WITHDRAWN OBJECTION***

3. The objection to the specification has been withdrawn due to Applicant's amendment to the abstract in the Amendment filed June 9, 2010.

***NEW OBJECTION***

4. The amendment filed June 9, 2010 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the specification does not provide support for the limitation that the total length of the molten mass (see Fig. 1 of Applicant's specification) is

Art Unit: 1782

equal to the "length of umbrella part of second resin". See 35 USC 112, first paragraph rejection of claims 1 and 2 made of record below.

Applicant is required to cancel the new matter in the reply to this Office Action.

***NEW REJECTION***

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1 and 2 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In regard to claim 1, the specification does not provide support for the limitation that the total length of the molten mass (see Fig. 1 of Applicant's specification) is equal to the "length of umbrella part of second resin". Since Fig. 1 shows that the "length of umbrella part of second resin" is less than the total length of the molten mass, the limitation that the total length of the molten mass (see Fig. 1 of Applicant's specification) is greater than the "length of umbrella part of second resin" is supported in Applicant's specification as originally filed. However, there does not appear to be a disclosure in Applicant's specification as originally filed that the total length of the molten mass may be equal to the "length of umbrella part of second resin".

Art Unit: 1782

Claim 2 is rejected under 35 U.S.C. 112, first paragraph, because it depends upon claim 1.

***UPDATED REJECTIONS***

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Shimizu et al. (USPN 4,816,308).

In regard to claim 1, Shimizu et al. teaches a resin mass having structural characteristics that correspond to the structural limitations that are positively recited in claim 1. See, for example, Fig. 3, and alternatively, Fig. 4. In regard to the last four lines of the claim, Shimizu et al. teaches an interlayer having structure that corresponds to the claimed structure. Compare Fig. 3 of Shimizu et al. with Applicant's Fig. 1. The total length of the resin mass shown in Fig. 3 and 4 of Shimizu et al. is greater than the "length of umbrella part of second resin".

9. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Collette et al. (USPN 5,759,653).

In regard to claim 1, Collette et al. teaches a resin mass having structural characteristics that correspond to the structural limitations that are positively recited in claim 1. See, for

Art Unit: 1782

example, Fig. 4, and alternatively, Fig. 5. In regard to the last four lines of the claim, Collette et al. teaches an interlayer having structure that corresponds to the claimed structure. Compare Fig. 4 and 5 of Collette et al. with Applicant's Fig. 1. The total length of the resin mass shown in Fig. 4 and 5 of Collette et al. is greater than the "length of umbrella part of second resin". Note that the second resin does not extend to the top of the resin mass shown in Fig. 4 and 5 of Collette et al..

In regard to claim 2, the recited distance of Collette et al. is 0 at the lowest point of the preform. See, for example, Fig. 4, and alternatively, Fig. 5.

10. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Kuwabara et al. (JP 03-234604) (English abstract filed with IDS).

In regard to claim 1, Kuwabara et al. teaches a resin mass having structural characteristics that correspond to the structural limitations that are positively recited in claim 1. See English abstract text and figures. In regard to the last four lines of the claim, Kuwabara et al. teaches an interlayer having structure that corresponds to the claimed structure. Compare figures of English abstract with Applicant's Fig. 1 (note the top of interlayer of Kuwabara et al. on either side is curved). The total length of the resin mass shown in Kuwabara et al. is greater than the "length of umbrella part of second resin".

11. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Kuwabara et al. (JP 03-234604).

Art Unit: 1782

In regard to claim 1, Kuwabara et al. teaches a resin mass having structural characteristics that correspond to the structural limitations that are positively recited in claim 1. See figures 3A-3D. In regard to the last four lines of the claim, Kuwabara et al. teaches an interlayer having structure that corresponds to the claimed structure. Compare figures 3A-3D with Applicant's Fig. 1 (note the top of interlayer of Kuwabara et al. on either side is curved). The total length of the resin mass shown in Fig. 3A-3D of Kuwabara et al. is greater than the "length of umbrella part of second resin".

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu et al. (USPN 4,816,308).

Art Unit: 1782

In regard to claim 2, Shimizu et al. teach the resin mass as discussed above in regard to claim 1. While Fig. 3 in particular appears to show a distance that corresponds to the claimed distance that is close to, if not about, 10%, Shimizu et al. teach that the relative amount of the resins A and B may vary widely and that it is desirable to achieve good transparency (col. 4, lines 37-57), it would have been obvious to one of ordinary skill in the art at the time the invention was made to have varied the thickness of the bottom layer of resin A, such as to decrease its thickness in order to achieve the desired degree of transparency, depending on the particular desired end results, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art in the absence of unexpected results. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). MPEP 2144.05 II.B. Since Resin B is the barrier layer, minimizing the thickness of the layers of resin A will not substantially affect the barrier properties of the container from which the resin mass is formed if at all.

### ***Response to Arguments***

14. Applicant's arguments in regard to the 35 U.S.C. 102 rejections of the claims based on Shimizu et al. (USPN 4,816,308), Collette et al. (USPN 5,759,653) and Kuwabara et al. (JP 03-234604 and English abstract filed with IDS) made of record in the previous Office Action have been fully considered but are not persuasive.

All references cited in the rejections anticipate the claimed molten resin mass. See the text of all of the rejections of record. Applicant argues that the references do not teach molten resin masses because they teach preforms. However, preforms correspond to molten resin masses. Many of Applicant's arguments appear to relate to how the preforms are made and used,



Art Unit: 1782

and do not appear to point out any structural differences that differentiate Applicant's claim language from any of the prior art references.

***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is (571) 272-1488. The examiner can normally be reached on Monday-Thursday from 9:00am to 7:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Walter B Aughenbaugh /

Examiner, Art Unit 1782

9/13/10

Application/Control Number: 10/576,414

Page 9

Art Unit: 1782